

APR 18 2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
David W. Roth et al.

Application No.: 09/216,206

Confirmation No.: 1079

Filed: December 18, 1998

Group Art Unit: 3622

For: INTERNET ADVERTISING SYSTEM

Examiner: John W. Van Bramer

VIA FAX: (571) 273-8300
ATTN: Office of Petitions

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.127 AND § 1.181
FROM THE EXAMINER'S REFUSAL TO ENTER AMENDMENT

Dear Sir:

This is a Petition under 37 C.F.R. § 1.127 and § 1.181 from the Examiner's refusal to enter an amendment.

Statement of Facts

1. The present application was filed on December 18, 1998. Heidi Kay and Russell Fradin were the originally named inventors of the present application.

2. The original specification as filed incorporated by reference U.S. Patent Application No. 08/787,979, filed on January 22, 1997 (the "979 application"). The '979 application names David W. Roth and Dylan F. Salisbury as the inventors. On September 4, 2001, the '979 Application issued as U.S. Patent No. 6,285,987.

3. On September 22, 2003, a new claim, claim 29, was added in the present

application. Claim 29 is supported by the disclosure of the '979 application.

4. On January 22, 2004, a substitute specification was filed in the present application. The substitute specification substantially incorporated the entire disclosure of the '979 application. In addition, the substitute specification added a first sentence to the specification, asserting for the first time that the present application is a continuation-in-part of the '979 application and thus entitled to the priority date of the '979 application.

5. On September 22, 2004, a petition was filed pursuant to 37 C.F.R. § 1.48, requesting a change in the inventorship of the present application, by deleting Heidi Kay and Russell Fradin, the previously named inventors, and adding David W. Roth and Dylan F. Salisbury as the only inventors of the present application.

6. On March 13, 2006, the petition to change the inventorship was granted. Accordingly, the currently named inventors of the present application are David W. Roth and Dylan Salisbury.

7. On March 5, 2007, a second substitute specification was filed. The second substitute specification again included a claim to priority to the '979 application.

8. In an Office Action mailed June 17, 2009, the Examiner asserted for the first time that "the substitute specification filed January 22, 2004 and March 5, 2007 have not been entered because it does not conform to 37 CFR 1.125(a)..." (emphasis added). Specifically, the Examiner held that any amendment to the specification claiming priority to the '979 application was improper, since according to the Examiner, the present application was not eligible for claiming priority to the '979 application.

9. On June 17, 2010, a Request for Continued Examination was filed, requesting, *inter alia*, reconsideration of the Examiner's holding that the present application was not entitled to claim priority to the '979 application.

10. On December 12, 2010, the Examiner issued an Office Action, once again refusing to enter the substitute specification of January 22, 2004 and March 5, 2007, and reasserting the Examiner's prior contention that the present application was not eligible to claim priority to the '979 application.

Argument

The Examiner's refusal to enter the substitute specification of January 22, 2004 and March 5, 2007 was in error and should be reversed by the Director. Specifically, the Examiner erroneously held that the instant application is not entitled to claim the benefit of priority to the '979 application. As a result, the Examiner erroneously refused to enter an amendment to the specification that would have added a claim to the priority date of the '979 application.

Pursuant to and in accordance with 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(1), a non-provisional application is entitled to claim priority to an earlier filed copending non-provisional application, when the following conditions are met: (1) the earlier application names at least one inventor named in the later-filed application; (2) the earlier application discloses the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. § 112; (3) the later-filed application is filed before the patenting or abandonment or termination of proceedings on the earlier application; and (4) the later-filed application contains or is amended to contain a reference to the prior-filed application, identifying it by application number in the manner and within the time periods set forth in 37 C.F.R. § 1.78(a)(2).

In the present application, all of the aforementioned requirements are satisfied.

While the instant application did not originally include an overlapping inventor with the '979 application, petitions under 37 C.F.R. § 1.48 were subsequently submitted and granted, whereby the inventorship of the instant application is now identical to the

inventorship of the '979 application. Therefore, the requirement that the earlier application name as an inventor at least one inventor named in the later-filed application is clearly satisfied.

In addition, although the instant application as originally filed did not include at least one claim relating to subject matter disclosed in the copending '979 application, the instant application was subsequently amended to include claimed subject matter disclosed in the '979 application in the manner set forth in 35 U.S.C. § 112 ¶ 1. Therefore, the requirement that the earlier application disclose the named inventor's invention claimed in at least one claim of the later-filed application is clearly satisfied.

In addition, with the filing of the substitute specification of January 22, 2004, a reference to the priority claim to the '979 application was added to the first paragraph of the specification.

Thus, three of the four requirements are indisputably satisfied. Nonetheless, the Examiner asserts that priority cannot be afforded to this application because of an alleged failure to satisfy the fourth requirement of "cendency".

It is undisputed that this application was filed before the issuance of the '979 application and hence the two applications are copending applications. Yet according to the Examiner, the mere fact that the earlier application was not patented or abandoned prior to the filing of the later application does not itself mean that copendency is met. Rather, according to the Examiner, copendency is only deemed satisfied when "the allegation of [priority] is made possible" prior to the issuance of the earlier patent application. See page 10 of Office Action of June 17, 2009. Here, the '979 application issued on September 4, 2001, while the continuation-in-part allegation only became possible on September 22, 2003 (the date new claims that identify subject matter disclosed in the earlier application were added). Therefore, the Examiner held, that under these circumstances there is no copendency and as such the instant application cannot benefit from the priority date of the '979 application.

Petitioner respectfully disagrees with the Examiner's contention. Nothing in the statute – 35 U.S.C. § 120, or in the corresponding regulations – 37 C.F.R. § 1.78(a), set forth a condition for copendency in the way the Examiner contends. Indeed, for copendency to be satisfied, 35 U.S.C. § 120 merely requires that the application itself be “filed before the patenting or abandonment of or termination of proceedings on the first application”. (emphasis added) There is nothing in the statute to suggest that copendency is not met unless the actual claims to the subject matter disclosed in the first application is submitted before the patenting or abandonment of the first application.

Hence, although the overlap of inventorship and the claim to the subject matter disclosed in the '979 application were presented two years after the '979 application was patented; nevertheless the applications are deemed to be copending because the instant application was “filed before the patenting ... of the ['979] application.”

Accordingly, Applicant respectfully requests that priority to the '979 application be duly afforded to this application.

The Examiner refusal to enter the substitute specifications filed on January 22, 2004 and March 5, 2007 was predicated on the Examiner's refusal to recognize the asserted claim to priority to the '979 application. Because the Examiner's holding regarding priority cannot be sustained, Petitioner respectfully requests reversal of the Examiner's refusal to enter the substitute specifications.

Dated: April 17, 2011

Respectfully submitted,

/Benzion A. Wachsman/

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* A statement under 37 CFR § 3.73(b) is being submitted herewith

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
David William Roth et al.

Application No.: 09/216,206

Confirmation No.: 1079

Filed: December 18, 1998

Group Art Unit: 3622

For: System and method for real-time bidding for
Internet advertising space

Examiner: John W. Van Bramer

STATEMENT UNDER 37 CFR § 3.73(b)

BEH Investments LLC, a Delaware limited liability company, states that it is the assignee of the entire right, title and interest in the patent application identified above, by virtue of a chain of title from the inventor of the patent application identified above, to the current assignee as shown below:

1. From: David W. Roth, Dylan F. Salisbury To: Orst, Inc.
The document was recorded in the United State Patent and Trademark Office at Real 008368, Frame 0113.
2. From: Orst, Inc. To: Flycast Communications Corp.
The document was recorded in the United State Patent and Trademark Office at Real 009836, Frame 0118.
3. From: Flycast Communications Corporation (a California corporation)
To: Flycast Communications Corporation (a Delaware corporation)
The document was recorded in the United State Patent and Trademark Office at Real 017811, Frame 0238.
4. From: Orst, Inc. To: Engage, Inc.
The document was recorded in the United State Patent and Trademark Office at Real 011903, Frame 0079.
5. From: Engage, Inc. To: BEH Investments LLC
The document was recorded in the United State Patent and Trademark Office at Real 013895, Frame 0778.
6. From: Craig R. Jalbert, Liquidating Supervisor To: BEH Investments LLC
The document was recorded in the United State Patent and Trademark Office at

Real **018535**, Frame **0073**.

The undersigned is duly authorized to act on behalf of Assignee.

Dated: April 17, 2011

Respectfully submitted,
Signature: /Benzion A. Wachsman/
Name: Benzion A. Wachsman
Title: General Manager